

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Applicants also acknowledge with appreciation the courtesies extended by Examiner Brian Yenke to Applicant's undersigned representative, Mr. Robert J. Webster during the personal interview conducted on July 28, 2004.

During that interview, all method claims and a new system claim were discussed. Examiner Yenke indicated during the interview that the claims, which had been forwarded to Examiner Yenke prior to the interview, appeared to patentably define over the applied art of record, i.e., over the Suh and Chor references. The claims forwarded to Examiner Yenke included new multiple dependent claim 22 and new system claim 23. In this Amendment, multiple dependent claim 22 is replaced by singularly dependent claims 22-25, and the new system claim is claim 26.

Claims 1-26 are now present in this application. Claims 1, 11, 13, 18 and 26 are independent. No new matter is involved. Claims 1, 8, 11, 13 and 18 have been amended. Claims 22-26 are newly added.

Reconsideration of this application, as amended, is respectfully requested.

Rejections Under 35 U.S.C. §103

Claims 1-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Suh and U.S. Patent No. 6,141,003 to Chor et al. (hereinafter, "Chor"). This rejection is respectfully traversed.

Independent claims 1, 11, 13 and 18 all recite a method of displaying a menu in a TV screen.

In the first place, Suh does not disclose displaying a menu for anything, let alone for the TV. Suh simply does not disclose an on-screen menu. Suh only mentions a menu in terms of a screen selection menu. That disclosure is found in col. 3, lines 41-44 in connection with Figs. 3A through 3E, none of which show a menu, let alone a screen selection menu.

Moreover, Suh's disclosure in col. 1, to which the Office Action refers, only discloses that "various kinds of communication services transmitted by the VAN (value added network), such as stock market quotes, news, weather or TV information, can be viewed on the TV screen." This is certainly not a disclosure of an on-screen TV menu, either explicit or inherent. With respect to inherency, it is instructive to note that inherency cannot be based on possibilities or probabilities, but must necessarily be present.

Accordingly, Suh does not disclose the displaying of an on-screen menu feature of the invention

The claims also recite “automatically resizing said menu element to a size other than a default resize value.” This feature is disclosed, for example, on pages 13- 15 of the main body of Applicants’ specification.

Suh clearly does not disclose such a feature.

The Office Action also admits that Suh does not set a screen as an interactive menu display screen or display an interactive menu element.

To remedy that deficiency, the Office Action alleges, with absolutely no objective evidence to support the allegation, that the use of interactive menu display screens and interactive menu elements being displayed/utilized is notoriously well known in the art.

Applicants respectfully submit that without providing objective evidence in support of this allegation in general, and with a reference that has a date prior to Applicants’ effective filing date, this allegation is wholly improper in a rejection made under 35 U.S.C. §103(a) and violates the substantive and procedural due process to which Applicants are entitled under the Administrative Procedures Act. See in this regard, *In re Zurko*, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and *In re Gartside*, 53 USPQ2d 1769 (Fed. Cir. 2000).

The factual basis for a rejection must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The Office also turns to the Chor reference, which discloses one size of menu icons and one size only. Nor does Chor disclose resizing its menu icons. In

fact, if there are too many icons in Chor, Chor eliminates one of those icons – see col. 9, lines 19-21, which states, “[I]f space in the favorites channels bar is limited, the least favorite channel icon may be removed with the addition of a new favorites icon.

This is objective evidence that Chor has absolutely no concept of resizing menu icons.

Applicants also respectfully submit the Office Action has not demonstrated that one of ordinary skill in the art would be motivated, i.e., have the desire, to modify Suh in view of Chor, as suggested.

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The reason given to combine these two references is nothing more than broad conclusory statements about both references, e.g., the ability to switch from a full screen mode to a window mode of operation.

There is no clear and particular showing that one of ordinary skill in the art would have the desire to provide an on-screen interactive menu feature to Suh.

Moreover, Suh discloses no need for an on-screen interactive menu, a feature that would add unnecessary extra complexity and expense to its system .

By failing to make out a *prima facie* case of proper motivation to combine the two applied references, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Furthermore, even if these two references were properly combined (which they are not, as discussed above) they would not result in the claimed invention which recites, among other features, "automatically resizing said menu element to a size other than a default resize value."

Accordingly, reconsideration and withdrawal of this rejection of claims 1-21 is respectfully requested.

#### Dependent Claims

Claims 2-10, 12, 14-17 and 19-21 depend, either directly or indirectly, on independent claims 1, 11, 13 and 18. Since neither Suh, nor Chor, discloses or suggests the above-recited features of independent claims 1, 11, 13 and 18, neither Suh, nor Chor, either singly, or in combination can render claims 2-10, 12, 14-17 and 19-21 obvious to one of ordinary skill in the art. Reconsideration and withdrawal of this art ground of rejection is respectfully requested.

Claim Amendments

The four independent claims have been amended to recite resizing the menu element to a size other than a default size. Claim 8 has been amended to actually recite the ratio corresponding to 100% so that the recited ratio actually is expressed in terms of a ratio, not a percentage. Claim 13 also is amended by deleting "a" to make the claim grammatically proper.

New Claims

Dependent claims 22-25 are added to recite a feature disclosed but not previously claimed and are allowable because they depend from claim 1. Support for the claimed feature is found, for example, on page 14, in the first full paragraph.

Claim 26 is a system claim corresponding to claim 1 and finds support in the original disclosure as does claim 1. New claim 26 is patentable at least for the reasons that corresponding claim 1 is patentable, as indicated above

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

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Art Unit 2614

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Pursuant to 37 C.F.R. §§1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8034, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or §1.17; particularly, extension of time fees.

Respectfully submitted,

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